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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of : Confirmation No. 4981
Hiroshi TAKANASHI et al. : Docket No. 2000_1749
Serial No.09/739,750 : Group Art Unit 1752
Filed December 20, 2000 : Examiner S. Lee

NEGATIVE-WORKING PHOTORESISTIVE
RESIN COMPOSITION AND PHOTORESISTIVE
RESIN PLATE USING THE SAME

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in reply to the Examiner's Answer dated November 4, 2003.

1. Rejection under 35 U.S.C. 112:

On page 6 of the Examiner's Answer, it is stated that the rejections of claims 1 and 3-5 under 35 U.S.C. 112 are withdrawn in view of Appellants' argument. This is taken to mean that the Examiner acknowledges that the claimed amount of component (E) in the present specification is 1.0-2.0 wt%, based on the weight of the photosensitive resin composition as solids.

2. Rejections under 35 U.S.C. 103:

(1) The Examiner states that all the rejections under 35 U.S.C. 103 are still maintained. Appellants maintain their arguments set forth in their Brief filed on July 21, 2003. Appellants wish to stress that the present invention is a "selection invention" within the broad range of the references.

(2) On page 8 of the Examiner's Answer, the Examiner states that the Appellants' Examples 1-34, shown in Table I do not prove unexpectedly superior results of using the component (E) in the amount of 1.0-2.0 wt.% based on the weight of the photosensitive resin composition (as solids); i.e., in Table I, the best results are obtained when the component (E) is used in the amount of 1.0-2.0 parts by weight along with 200 parts by weight of water, 200 parts by weight of polyvinyl alcohol, 70 parts by weight of polyethylene glycol diacrylate, 4 parts by weight of benzylidemethylketal, and 0.1 parts by weight of methylhydroquinone; and therefore, the amount of 1.0-2.0 parts by weight for the component (E) is not the same as the presently claimed 1.0-2.0 wt% based on the weight of the photosensitive resin composition (as solids).

In reply, Examples 1-34 shown in Table I are the same as those shown in the Declaration executed September 25, 2000 and filed in parent application Serial No. 09/262,077 on December 20, 2000, as pointed out by the Examiner.

Both in the Declaration executed September 25, 2000 and in paragraph [0056] of the present specification, the passage "X parts by weight (X: addition amount indicated in Table I below)" should read "X wt% based on the weight of the photosensitive resin composition as solids (X: addition amount indicated in Table I below)". The passage is erroneously set forth as is the case with the parent application.

The data in Table I on page 23 of the specification as well as the Declaration were actually obtained by the addition of p-toluenesulfonamide or o-toluenesulfonamide, as component (E), in an amount of X wt% based on the weight of the photosensitive resin composition as solids in order to show the criticality of the range of the present invention and to prove unobviousness of the present invention over the Pine reference.

Appellants acknowledge that the passages relating to weight % basis were erroneously set forth in the Declaration as well as in paragraph [0056] of the specification. Thus, "X parts by weight (X: addition amount indicated in Table I below)" in the Declaration executed September 25, 2000 was erroneous, and should correctly read "X wt.% based on the weight of the photosensitive resin composition as solids (X: addition amount indicated in Table I below)".



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It is not clear if the Examiner is contending that the data discussed above is not representative of the claimed scope because it only employs specific types of components (A)-(D), but if this is the Examiner's contention, he has provided no basis therefor.

In order to provide a meaningful comparison, it is necessary to control only a single variable and it is not reasonable to require varying all of the other components, i.e. (A)-(D).

There is nothing in the specification that indicates that these other components are critical, as can be seen from the discussion in paragraphs [0025] through [0031].

The criticality here is with respect to component (E) as can be seen from [0032] and a correct reading of the Declaration.

For the foregoing reasons taken with those set forth in Appellants' brief, reversal of the Final Rejection is respectfully requested.

This Reply Brief is submitted in triplicate.

Respectfully submitted,

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